

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re the Application of

Nils-Erik ENGSTROM

Confirmation: 1806

Serial No.: 10/580,191

Group Art Unit: 3635

Filed: February 26, 2007

Examiner: SAFAVI, Michael

For: **JOINT FOR A PANEL**

APPEAL BRIEF

Thomas P. Pavelko
Registration No.: 31,689
NOVAK DRUCE & QUIGG LLP
300 New Jersey Ave, NW
Fifth Floor
Washington, D.C. 20001
Telephone: (202) 659-0100
Facsimile: (202) 659-0105

Attorney for Appellant

Date: July 6, 2011

(i) REAL PARTY IN INTEREST

The real party in interest is the assignee of the inventor's interest, Pergo AG, a company formed under the laws of Switzerland having a principal address in Baar, Switzerland.

(ii) RELATED APPEALS AND INTERFERENCES

There is no known prior or pending appeals, judicial proceedings or interferences, known to Appellant, his assignee, or undersigned counsel which may be related to, directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

(iii) STATUS OF CLAIMS

Claims 1-7 and 12-13 are the subject matter of this appeal.

Claims 8-11 and 14-16 all the remaining claims in the application, have been canceled.

(iv) STATUS OF AMENDMENTS

A single amendment has been filed subsequent to the Final Rejection, cancelling claims 10-11 which has been entered as noted in the Advisory Action of February 15, 2011.

(v) SUMMARY OF CLAIMED SUBJECT MATTER

The sole independent claim on appeal (claim 1) is directed to a joint between two panels (Figs. 1a-1c) (Specification, page 4, second paragraph). The joint comprises a first edge 1 and a second edge 1¹ (Fig. 1a) (Specification, page 4, second paragraph).

The first edge 1 comprises a groove 11 (Fig. 1a) and the second edge 1¹ comprises a tongue 21 (Fig. 1a) (Specification, page 4, second paragraph). The second edge 1¹ also comprises an upper side groove 12 (Fig. 1a) (Specification, page 4, second paragraph).

A joining profile 3 (Fig. 1a) (Specification, page 4, second paragraph) comprises an elastomer material (Specification, page 6, lines 16-17) and is provided with at least one tongue 31 (Fig. 1a) (Specification, page 8, lines 8-9) and an intermediate section 33 (Fig. 1a) (Specification, page 8, lines 8-9).

The joining profile 3 being so configured so as to allow the joining profile 3 to be located in the upper portion of the joint between two panels 1, 1^t (Fig. 1b and 1c) (Specification, page 8, lines 9-11).

Features of the dependent claims can be found in the annotated Exhibit 1 (annotated drawing figures 1a, 1b).

Exhibit 1

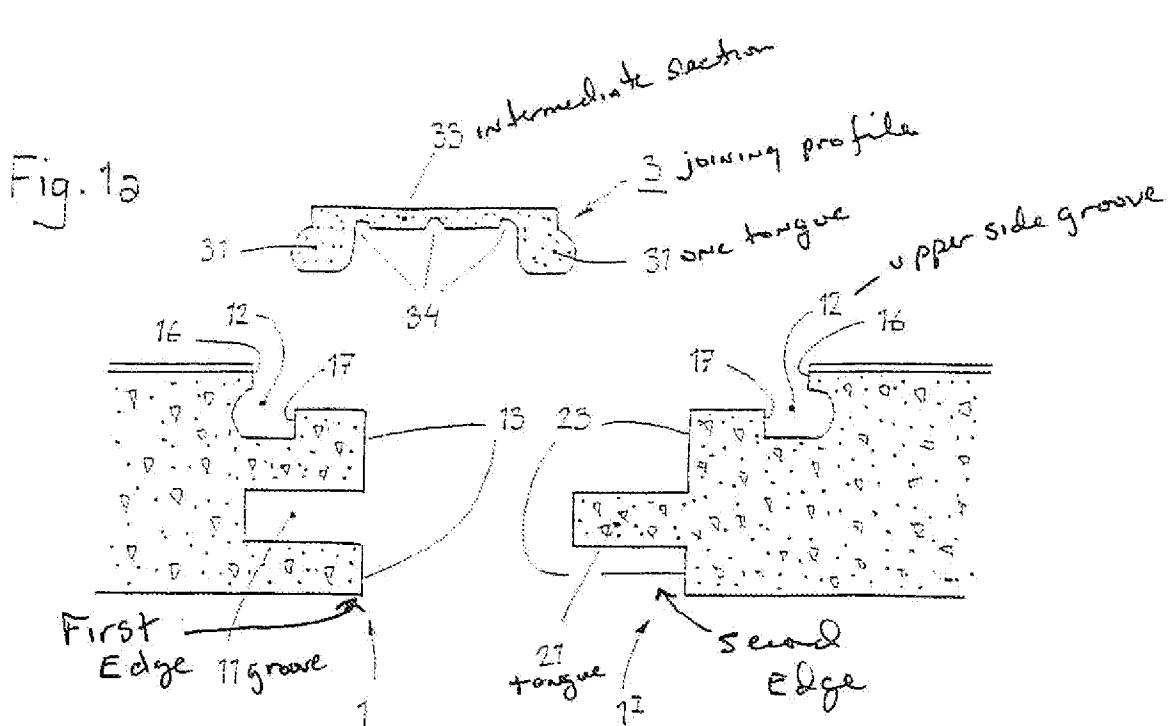
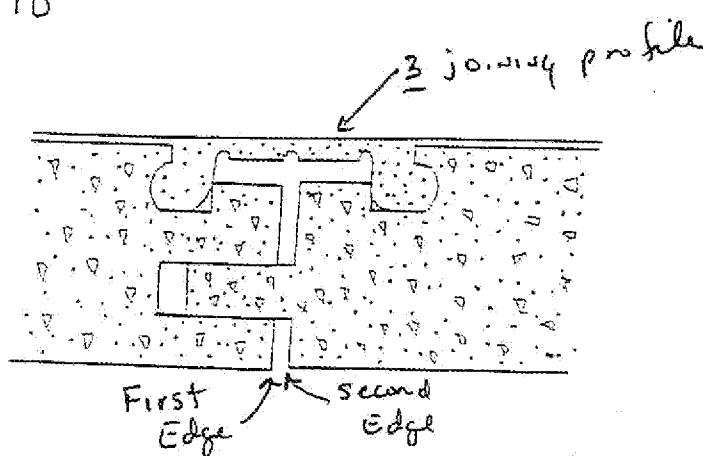


Fig. 1b



(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- (1) CLAIMS 2-4, 6, 7 AND 12-13 ARE REJECTED UNDER 35 U.S.C. 112, FIRST PARAGRAPH AS ALLEGEDLY FAILING TO COMPLY WITH THE WRITTEN DESCRIPTION REQUIREMENT.
- (2) CLAIMS 2-4, 6, 7 AND 12-13 ARE REJECTED UNDER 35 U.S.C. 112 SECOND PARAGRAPH AS ALLEGEDLY BEING INDEFINITE FOR FAILING TO PARTICULAR POINT OUT DISTINCTLY CLAIMED THE SUBJECT MATTER WHICH APPLICANT REGARDS AS THE INVENTION.
- (3) CLAIMS 1-7 AND 12-13 STAND REJECTED UNDER 35 U.S.C. 102 (a) AS ALLEGEDLY ANTICIPATED BY U.S. PATENT PUBLICATION NO. 2003/0024199 TO PERVAN ET AL. (HEREINAFTER PERVAN).

(vii) ARGUMENT

1. The rejection of the claims 2-4, 6, 7 and 12-13 under 35 U.S.C. 112, first paragraph

As to the allegation that claims 2-4, 6, 7 and 12-13 fail to comply with the written description requirement, Applicant notes that the written description not only includes the specification, but also the drawings which are a part thereof, 35 U.S.C. 113, first sentence.

While the Examiner alleges that there does not appear to be a second upper side groove along the second edge, Applicant directs the Board's attention to the previous description of Fig. 1a as annotated in Exhibit 1 above which clearly shows the second edge as being the right hand side of Fig. 1a (as including the tongue 27) and that element 12 denotes the upper side groove.

Applicants note that in claim 2 the term "second upper side groove" is to use to delineate such a groove from the term "upper side groove" 12 in the first edge as clearly recited therein.

Thus, there is clearly a [first] upper side groove 12 in the first edge and a [second] upper side groove 12 in the second edge as clearly disclosed in Applicant's original description of the invention; See also the specification, page 8, lines 7-8. Accordingly, the specification clearly complies with the written description requirement and reversal of the rejection is warranted.

2. The rejection of the claims 2-4, 6, 7 and 12-13 under 35 U.S.C. 112 second paragraph

While the Examiner alleges that these claims are vague and indefinite, firstly Applicant points out that Congress has left it solely to Applicant to recite the subject matter that he regard as his invention (35 U.S.C 112, second paragraph). See also *In re Borkowski*, 164 USPQ 642, 645 (CCPA1970).

There are two upper side grooves in the claimed joint. A [first] upper side groove 12 in the first edge (see Fig. 1a and specification page 8) and a [second] upper side groove 12 in the second edge (see Fig. 1a and the specification page 8) and thus the recitation of an "upper side groove" in the first edge and a "second upper side groove" in the second edge is as Applicant had intended and this language means exactly what the inventor regards as the subject matter of his invention. Secondly, with regard to line 3 of claim 2 which presents the term "a first, and a second, snapping tongues" the Examiner questions whether there are a "plurality" of first snapping tongues and a plurality of second tongues. Applicant never uses the term "plurality" as recited by the Examiner anywhere in the claim and thus the Examiner appears to be requesting Applicant to opine on terms not used by Applicant in his claims. This is not a proper basis for rejecting the claims under 35 U.S.C. 112, second paragraph. As to the recitation in lines 4-5 of claim 2, that "the joining profile be so configured so as to allow each of the first and second snapping tongues to be fitted into the first and second upper side grooves of the two, joined adjacent panels", and to the Examiner's query as to how it is not clear, Applicant again respectfully directs the Board's attention to Fig. 1a and the assembled joint and joining profile in Fig. 1b as to how this is achieved. Lastly, with regard to the Examiner's final query as to claim 2, Applicant only directs the Board's attention to the fact that dependent claims are to be in compliance with 35 U.S.C., 112 fourth paragraph and further limit the claim from which they

depend. Thus, the tongue of the joining profile has now been further limited in the “at least” terminology to be specifically a “first, and a second” but also has further limited the style of the tongue to be “snapping” where independent claim 1 is not so limited. Accordingly claim 2 is in compliance with 35 U.S.C. 112, second paragraph.

The Examiner again sets up a straw man argument with regard to claim 3 as alleging that “mating surfaces” is the same as a “a first edge and a second edge” introduced in claim 1. This is not true. It is basic patent law that different words in different claims mean different things. This is the basis of claim differentiation. The terms “first edge” and “second edge” only define the edges of the panel. Claim 3 defines “mating surfaces,” e.g. see Fig. 1b, which are only limited portions of the “edges” of the panel. Thus, the term “mating surfaces” does not mean the same thing as the “first and second edges”. Claim 3 is therefore in compliance with 35 U.S.C. 112, second paragraph.

The rejection of claim 7 appears to be made solely because the Examiner has omitted the phrase “a portion” of a panel from his reading of the claim. Applicant is not defining the “whole” panel but here “a portion of the panel” in the portion between the upper side groove and the panels respective distal edge which has a recess (e.g., See 14 in Fig. 3a) (See also specification, page 10, lines 2-4) therefore claim 7 complies with 35 U.S.C. 112, second paragraph.

The Examiner’s query as to claim 12 is specious. Applicant has previously pointed out that claim 2 (upon which claim 12 depends) recites an “upper side groove” and a “second upper side groove”. Therefore, the term “the upper side groove” refers to the term “upper side groove” in claim 2. With regard to the term “the distance...” Applicants again point out that the Examiner is only reading a portion of the term as recited in the claim. Applicants again respectfully direct the Board’s attention to the specific recitation of claim 12 that “between the first and second groove edge surfaces a predetermined distance is present, the distance being so configured...”. Thus, it is not merely a “distance” but the distance between two elements that is being configured. As to the query to line 4, the snapping tongue is a snapping tongue that fits

into “upper side groove” previously discussed above. Thus, claim 12 clearly complies with 35 U.S.C. 112, second paragraph.

The limitations of claim 13 refer to claim 12 (previously discussed) and thus “the upper side groove” is the groove provided in the panel having a first groove edge and a second groove edge surface in which an undercut is present. Again, it appears the Examiner fails to read the claims in compliance with statute (35 U.S.C. 112, fourth paragraph) such that each further dependent claim further limits the claims from which it depends. Claim 13 accordingly complies with 35 U.S.C. 112 second paragraph. Reversal of all rejections under 35 U.S.C. 112, second paragraph, is therefore requested.

3. The rejection of claims 1-7 and 12-13 under 35 U.S.C. 102 (a) as being anticipated by Pervan.

In order to constitute “anticipation”, the cited reference must teach each and every element of the claim, see generally MPEP Section 2131. While the Examiner refers to Figs. 8c, 10b, 15c and 17c as disclosing a joint between two panels, there is no joining profile in Pervan. While the Examiner refers to 55 as “a joining profile”, Pervan clearly discloses 55 as a sealant not a joining profile. Moreover Pervan does not disclose in any of Figs. 8c, 10b, 15c, 17c, or elsewhere, a second edge further comprising an upper side groove or even a first edge comprising an upper side groove. In each of Figs. 8c, 10, 15c and 17c, the panels have no upper grooves of any type (see Figs. 8e, 10, 15e and 17e, respectively), and in each case sealant 55 is below the upper sides of the panel and is internal of the panel upper sides. Because Pervan does not even teach anticipation of independent claim 1, it cannot possibly render anticipatory any of dependent claims 2-7 and 12-13 which by statute (35 U.S.C. 112, fourth paragraph) incorporate by reference all the limitations of the claim to which it refers. Reversal of the rejection is therefore respectfully requested.

(viii) CONCLUSION

Again, the examiner's statement of anticipation is merely conclusory but she makes no attempt at satisfying her burden of establishing a factual basis to support the naked conclusion of anticipation. The purported queries of lack of compliance of the claims under 35 U.S.C. 112, first and second paragraph have been addressed above are the claims are clearly in compliance with the statute.

For the foregoing reasons, reversal of all rejections by the Board are respectfully requested.

(ix) CLAIMS APPENDIX

A copy of the claims on Appeal can be found in claims Appendix

(x) EVIDENCE APPENDIX

Not applicable

(xi) RELATED PROCEEDING APPENDIX

Not applicable

Respectfully submitted,



Thomas P. Pavelko

Date: July 6, 2011
Atty Docket No. 8688.048.US0000

Registration No.: 31,689

APPEAL BRIEF
Application No. 10/580,191
Atty Docket No. 8688.048.US0000

APPENDICES

The following Appendices are attached to and made a part of this brief:

Appendix A	Claims on Appeal
Appendix B	Evidence (N/A)
Appendix C	Related Proceedings (N/A)

APPEAL BRIEF
Application No. 10/580,191
Atty Docket No. 8688.048.US0000

APPENDIX A: Claims on Appeal

1. A joint between two panels, the joint comprising a first edge and a second edge whereby the first edge comprises a groove and the second edge is provided with a tongue wherein the second edge further comprises an upper side groove, and a joining profile, the joining profile comprises an elastic material and is provided with at least one tongue and an intermediate section, the joining profile being so configured so as to allow the joining profile to be located in the upper portion of the joint between the two panels.
2. The joint for a panel according to claim 1, wherein the first edge further comprises an upper side groove and the second edge comprises a second upper side groove, and the joining profile comprises a first, and a second, snapping tongues, the joining profile being so configured so as to allow each of the first and second snapping tongues to be fitted into the first and second upper side grooves of the two, joined, adjacent panels.
3. The joint according to claim 2 wherein the joint further comprises mating surfaces wherein the joining profile and the upper side grooves are so configured that a play is created in the joint between the mating surfaces.
4. The joint according to claim 3 wherein the play is in the range of 0.05 - 1 mm.
5. The joint according to claim 1 wherein the tongue and the groove are configured to

limit the movement in a vertical direction between the two panels.

6. The joint according to claim 2 wherein the joining profile and the upper side grooves are configured to limit the movement in a horizontal direction between the two panels.

7. The joint according to claim 2 wherein a portion of a panel arranged between the upper side groove and the panel's respective distal edge portion comprises a recess.

12. The joint according to claim 2 wherein the upper side groove is provided with a first groove edge surface and a second groove edge surface, and between the first and second groove edge surfaces a predetermined distance is present, the distance being so configured that the snapping tongue may be pressed in between the first and second groove edge surfaces.

13. The joint according to claim 12 wherein the first and second groove edge surfaces are arranged so that an undercut is present, that the snapping tongue of the joining profile is configured with respect to the undercut so that a snap action locking effect is achieved.

*APPEAL BRIEF
Application No. 10/580,191
Atty Docket No. 8688.048.US0000*

APPENDIX B: Evidence Appendix under 37 CFR §41.37(c)(1)(ix)

N/A

APPEAL BRIEF
Application No. 10/580,191
Atty Docket No. 8688.048.US0000

APPENDIX C: Related Proceedings Appendix under 37 CFR §41.37(c)(1)(x)

N/A